

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:

Hartmut S. Engel

Application No.: 10/541,444

Confirmation No.: 6382

Filed: June 9, 2006

Art Unit: 2875

For: BUILT-IN LIGHT

Examiner: Mary E. Zettl

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the final Office Action mailed July 2, 2009, Applicant appeals the final rejection of claims 1-12 and 14-17 in this case. Attached hereto is Applicant's Notice of Appeal dated September 30, 2009. Applicant avers as follows:

**I. REAL PARTY IN INTEREST**

The real party in interest is Hartmut S. Engel, an individual residing in Ludwigsburg, Germany.

**II. RELATED APPEALS AND INTERFERENCES**

None.

**III. STATUS OF CLAIMS**

Claims 1-12 and 14-17 are pending in this application. Claims 13 and 18-20 have been canceled. No claims have been allowed.

#### IV. STATUS OF AMENDMENTS

Applicant appeals from the Patent Examiner's final rejection of claims 1-12 and 14-17.

An amendment dated September 2, 2009, was filed in this case. That amendment, furthermore, was considered by the Patent Examiner as per the Patent Examiner's Advisory Action dated September 18, 2009, and has been entered.

#### V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 forms the only independent claim in the instant application. It is reproduced below on the left with reference to the corresponding portion of the specification and drawing on the right-hand column.

A built-in lamp comprising a holder for fastening in an installation surface (11),

The holder or housing 10 is mounted in an installation surface 11; see FIG. 2 and patent specification page 11, lines 6-11.

a bulb (6) and a reflector, with a reflector opening disposed in the direction of illumination defining a generally planar direct light discharge region (1),

A bulb 6 and reflector 4 are provided in the housing with the reflector opening 3 defining a direct light discharge region 1; see FIG. 2 and patent specification page 9, lines 9-13 and 24-25.

which is surrounded by a generally coplanar diffuse light discharge region (2) such that scattered light is discharged from the diffuse light discharge region (2) around the direct light discharge region (1), characterized in that

The direct light discharge region 1 is surrounded by a generally coplanar diffuse light discharge region 2 so that scattered light is discharged from the diffuse discharge region 2 around the direct light discharge region 1; see FIG. 2 and patent specification page 9, lines 9-11.

the bulb (6) and the direct light reflector (4) are arranged in a housing (10), said housing having a planar inner surface which overlies the reflector and which forms an additional reflector (7) which reflects at least a portion of light from said bulb to said diffuse light discharge region; and

The bulb 6 and the direct light reflector 4 are contained within the housing 10. The housing 10 also includes a planar inner surface 7 which overlies the reflector and forms an additional reflector which reflects at least a portion of the light from the bulb 6 to the diffuse light discharge region 2; see FIG. 2 and patent

specification page 9, lines 7, 4 and page 13, lines 6-24.

in that the housing (10) is terminated in at least a largely dust-proof manner by a transparent planar plate extending across and covering said direct light discharge region and a planar scattering plate extending across and covering said diffuse light discharge region, said transparent planar plate and said planar scattering plate being coplanar with each other, and

wherein the direct light discharge region (1) has a circular shape, and the diffuse light discharge region (2) is bounded on the inner side by a circular line (3) and on the outer side by a polygonal line or by a further circular line.

A transparent plate 13 extends across the bottom of the housing 10 and thus across the direct light discharge region 1. The plate 13 is coplanar with the scattering plate 15 which extends across the bottom of the diffuse light discharge region 2; see FIG. 2 and patent specification page 15, lines 20-28 of the specification.

The direct light discharge region 1 is circular in shape terminating in a circular line 3; see FIG. 1 and patent specification page 9, lines 15-18. A polygonal line or further circular line surrounds the direct light discharge region to define the outside of the diffuse discharge region and which may be circular or polygonal in shape. There are no "means for" paragraphs in claim 1.

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Patent Examiner has rejected claims 1-11 and 14 under 35 U.S.C. §103 as unpatentable over Müggenburg (EP 1 033 530 A2) in view of Jongewaard et al. (U.S. Patent No. 6,561,670), Martin (EP 0 648 971) and Nagler (EP 0 678 700).

The Patent Examiner rejects claim 12 as unpatentable over Müggenburg, Jongewaard, Martin, Nagler and in further view of U.S. Patent No. 4,088,883 to Dey.

Claims 15, 16, 18 and 19 are rejected as unpatentable over Müggenburg, Jongewaard, Martin, Nagler and in further view of U.S. Patent No. 5,060,120 to Kobayashi.

## VII. ARGUMENT

- A. The Patent Examiner's rejection of claims 1-11 and 14 as unpatentably obvious over of Müggenburg, Jongewaard, Martin and Nagler is improper and should be reversed.

The Patent Examiner's primary reference to Müggenburg admittedly discloses a light having a direct discharge region 5 as well as two diffuse discharge regions 21a and 21b. Consequently, light from the light bulb 7 of Müggenburg travels both downwardly through the direct light discharge region 5 while a portion of the light is reflected off the reflector surface 12 and through the diffuse discharge regions 21a and 21b.

On page 2 of the Patent Examiner's July 2, 2009, Office Action, the Patent Examiner first takes the position that the Müggenburg patent teaches a built-in lamp with a direct discharge region being "coplanar" to a diffuse discharge region. Applicant assumes that the Patent Examiner takes this position since claim 1 in the instant application clearly requires that the direct light discharge region 1 must be not only surrounded by but also coplanar with the diffuse discharge region 2; see claim 1, lines 3-4.

As understood from page 2 of the July 2, 2009, Office Action, the Patent Examiner's position is that the entire volume surrounded by the reflector 3 or "between the surfaces of item 3 and under item 5" of Müggenburg would be considered as the direct light discharge region. According to the Examiner, this direct discharge region is thus within the lamp structure. The Patent Examiner further continues that the diffuse light discharge region encompasses the entire area below the scattering plates 21a and 21b and thus outside the lamp structure. The Examiner then concludes that a plane could be formed which extends through both the direct and diffuse light discharge regions. However, for the reasons set forth below, Applicant respectfully submits that this interpretation and construction of claim 1 by the Patent Examiner is simply incorrect.

First, it is well established that a patent claim must be interpreted in light of the patent specification. Although the patent claim must be interpreted as broadly as reasonably permitted, the Patent Examiner cannot torture the English language and ignore the clear meaning from the patent specification when applying prior art to the patent claims. That, however, is what has happened in this case.

More specifically, claim 1 clearly defines the direct light discharge region as number 1 and the diffuse light discharge region as number 2. These are clearly shown as being coplanar in FIG. 2 of the patent drawing and both represent the planes through which light passes out through the lamp.

If, however, the planar light discharge region is created as a volume and the diffuse light discharge region is also treated as a volume, as the Patent Examiner has done here, then the word “coplanar” has absolutely no meaning at all. More specifically, given two volumes, a plane can always be constructed which passes through both of those volumes regardless of the position of the volumes relative to each other. Consequently, in order to give the word “coplanar” any meaning at all, it must necessarily mean the plane of the transparent sheet for the direct light discharge region 1 and the scattering sheet for the diffuse light discharge region 2. These are clearly coplanar in the instant application and are clearly not planar in the Müggenburg patent.

The Examiner’s misinterpretation of the claim language is also clear since, according to the Examiner, the direct light discharge region is contained inside the Müggenburg housing while the diffuse discharge region is contained outside the housing. There is simply no basis for such an interpretation other than an attempt to read Müggenburg on claim 1.

Furthermore, the Patent Examiner’s incorrect claim construction for the Müggenburg patent is also clear from the Müggenburg patent itself. Specifically, in column 6, lines 14-15,

Müggenburg clearly defines item 5 as a light discharge opening or “Lichtaustrittsöffnung 5”. That direct light discharge region 5 of Müggenburg is clearly not coplanar, or even nearly coplanar, with the diffuse light discharge regions 21a and 21b of Müggenburg.

The secondary references relied upon by the Patent Examiner fail to cure this deficiency of the Müggenburg patent. Specifically, the Jongewaard patent admittedly teaches a light construction having a lamp with a light emitting region 42. However, there is no suggestion or teaching in the Jongewaard patent of providing a reflective surface on the housing that overlies the main reflector as required by claim 1 in the instant application and which reflects light to the diffuse light discharge region as required by claim 1. Likewise, there is absolutely no teaching or suggestion in the Jongewaard patent of a direct light discharge region and diffuse light discharge region that are coplanar with each other as required by claim 1 in the instant application.

The Patent Examiner’s third reference to Martin also fails to show, teach or suggest direct light and diffuse light discharge regions which are coplanar with each other as required by claim 1. More specifically, in Martin, the bottom of the main reflector 2 forms a direct light discharge region in a manner similar to Müggenburg. Martin actually fails to disclose a diffuse light discharge region at all but, if any area of Martin would correspond to the diffuse light discharge region, it would be the bottom of the housing extending just below the installation surface. Such a plane for the diffuse light discharge region is clearly not coplanar, or even nearly coplanar, with the direct light discharge region as required by claim 1 in the instant application.

Indeed, despite the Patent Examiner’s initial assertion on page 2 of the July 2, 2009, Office Action that Müggenburg teaches a direct and diffuse discharge region that are coplanar with each other, on page 5 of that Office Action, the Patent Examiner finally concedes that the combination of Müggenburg, Jongewaard and Martin does not teach coplanar diffuse and direct

light discharge regions. Specifically, on page 5 of the July 2, 2009, Office Action, second paragraph, the Patent Examiner says in part as follows:

Muggenburg, Jongewaard et al. and Martin do not disclose expressly the scattering region and the transparent regions of the plates being coplanar to one another.

Consequently, in order to cure this deficiency of Müggenburg, Jongewaard et al. and Martin, the Patent Examiner further relies upon the Nagler patent. Applicant, however, respectfully submits that the Patent Examiner has simply misread the Nagler patent.

More specifically, if the plate 5 of Nagler is considered to be the direct light discharge region – and that itself is somewhat a stretch of the English language – then the reflecting beads 8 attached to the bottom of the plate 5 would correspond to the diffuse light discharge region. These beads 8 of Nagler, however, are simply not coplanar with the plate 5 of Nagler. Instead, they are clearly positioned below the Nagler plate 5 and thus are not “coplanar” as required by claim 1 in the instant application.

Furthermore, claim 1 in the instant application clearly requires that the diffuse light discharge region is bounded on its inner side by a circular line. That simply is not true for the Nagler patent. Instead, as best shown in FIG. 2 of Nagler, the scattering beads 8 are in the shape of a multi-petal flower, not the circular line required by claim 1. As such, the entire purpose of Nagler is entirely different than the instant invention. Nagler provides a decorative light whereas the present invention provides a lamp for illumination.

Claim 1 of the instant application further requires that the diffuse light discharge region surround the direct light discharge region. That, however, is simply not true for the Nagler patent. Instead, the scattering beads 8 of Nagler extend all the way to the center of the plate 5 as shown in FIG. 2. As such, these light scattering beads 8 are aligned with the direct light

discharge region. Indeed, the light scattering beads of Nagler extend all the way from the outside of the reflector 2 to directly align with the center of the reflector 2, so that the diffuse region of Nagler does not surround the direct discharge light region as required by claim 1.

For all the foregoing reasons, Applicant respectfully submits that the Patent Examiner's combination of Müggenburg, Jongewaard et al., Martin and Nagler simply fails to teach Applicant's invention as it is clearly defined in claim 1 of the instant application.

Furthermore, the present invention is a very simple built-in lamp structure. Indeed, it is such a simple mechanical structure that only a handful of numbers is required to describe all of its components.

Despite that, the Patent Examiner relies upon no less than four prior art references in the Examiner's rejection of claim 1 in this application. In fact, what the Patent Examiner has done is to simply select individual components from the various prior art references and then, with the advantage of hindsight obtained from a reading of Applicant's disclosure, reassembled these components together in an attempt to reconstruct Applicant's invention. Such a reconstruction of Applicant's invention, however, results not from obviousness as required by 35 U.S.C. §103, but rather from hindsight obtained from Applicant's disclosure.

For example, there is absolutely no reason for one to utilize the decorative semitransparent plate of Nagler with any of the other prior art references. Similarly, the lamp construction of Müggenburg is of the fluorescent type in which an elongated light bulb 7 extends down the center of the housing with two light scattering plates on opposite sides of the bulb 7. There simply is no reason to combine the Müggenburg reference with any of the other prior art references cited by the Patent Examiner.

Hindsight, of course, cannot form the basis for obviousness under 35 U.S.C. §103.

There, Applicant respectfully submits that the Examiner's rejection of claims 1- 11 and 14 as unpatentably obvious over Muggenburg, Jongewaard, Martin and Nagler is improper and should be reversed.

- B. The Examiner's rejection of claim 12 as unpatentably obvious over Muggenburg, Jongewaard, Martin, Nagler and Dey is improper and should be reversed.

The deficiencies of the Examiner's combination of Muggenburg, Jongewaard, Martin and Nagler have already been discussed with respect to claims 1 – 11 and 14, which discussion is incorporated by reference. The Dey patent ( patent number 5 in the combination ) merely discloses a one piece plate with a transparent and scattering region. It does not, however, overcome the basic deficiencies of Muggenburg, Jongewaard, Martin and Nagler.

There, Applicant respectfully submits that the Examiner's rejection of claim 12 as unpatentably obvious over Muggenburg, Jongewaard, Martin, Nagler and Dey is improper and should be reversed.

- C. The Examiner's rejection of claims 15, 16, 18 and 19 as unpatentably obvious over Muggenburg, Jongewaard, Martin, Nagler and Kobayashi is improper and should be reversed.

The deficiencies of the Examiner's combination of Muggenburg, Jongewaard, Martin and Nagler have already been discussed with respect to claims 1 – 11 and 14, which discussion is incorporated by reference. The Kobayashi patent (patent number 5 in the combination ) merely discloses lighting fixture in which the bulb is pivotally mounted. It does not, however, overcome the basic deficiencies of Muggenburg, Jongewaard, Martin and Nagler.

There, Applicant respectfully submits that the Examiner's rejection of claim 15 and 16 (claims 18 and 19 have been cancelled ) as unpatentably obvious over Muggenburg, Jongewaard, Martin, Nagler and Kobayashi is improper and should be reversed.

### VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include all the amendments filed by Appellant.

### IX. EVIDENCE

The evidence involved in the present appeal is listed in attached Appendix B.

### X. RELATED PROCEEDINGS

The related proceedings involved in the present appeal are listed in attached Appendix C.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 07-1180.

Dated: December 14, 2009

Respectfully submitted,

Electronic Signature: /Douglas W. Sprinkle/  
Douglas W. Sprinkle  
Registration No.: 27,394  
GIFFORD, KRASS, SPRINKLE,  
ANDERSON & CITKOWSKI, P.C.  
2701 Troy Center Drive, Suite 330  
Post Office Box 7021  
Troy, Michigan 48007-7021  
(248) 647-6000  
(248) 647-5210 (Fax)

Attorney for Appellant

APPENDIX A

1. A built-in lamp comprising a holder for fastening in an installation surface (11), a bulb (6) and a reflector, with a reflector opening disposed in the direction of illumination defining a generally planar direct light discharge region (1), which is surrounded by a generally coplanar diffuse light discharge region (2) such that scattered light is discharged from the diffuse light discharge region (2) around the direct light discharge region (1), characterized in that

the bulb (6) and the direct light reflector (4) are arranged in a housing (10), said housing having a planar inner surface which overlies the reflector and which forms an additional reflector (7) which reflects at least a portion of light from said bulb to said diffuse light discharge region; and

in that the housing (10) is terminated in at least a largely dust-proof manner by a transparent planar plate extending across and covering said direct light discharge region and a planar scattering plate extending across and covering said diffuse light discharge region, said transparent planar plate and said planar scattering plate being coplanar with each other, and

wherein the direct light discharge region (1) has a circular shape, and the diffuse light discharge region (2) is bounded on the inner side by a circular line (3) and on the outer side by a polygonal line or by a further circular line.

2. A built-in lamp in accordance with claim 1, characterized in that the direct light discharge region (1) and the diffuse light discharge region (2) can be acted on by a common bulb (6).

3. A built-in lamp in accordance with claim 1, characterized in that the reflector opening defining the direct light discharge region (1) is associated with a direct light reflector (4) on whose side remote from the direct light discharge region (1) an additional reflector or background reflector (7) is provided.

4. A built-in lamp in accordance with claim 1, characterized in that a light passage region is formed between the additional reflector (7) and the direct light reflector (4).

5. A built-in lamp in accordance with claim 1, characterized in that the diffuse light discharge region (2) can only be acted on indirectly by the bulb (6) via the additional reflector (7).

6. A built-in lamp in accordance with claim 1, characterized in that the additional reflector (7) is formed at least partly by at least one planar or pre-determinably curved or kinked reflector surface which ensures a pre-determinable splitting of the portion of the reflected light directed to the direct light discharge region (1) and to the diffuse light discharge region (2).

7. A built-in lamp in accordance with claim 1, characterized in that the housing (10) is made to be light-proof and/or dust-proof.

8. A built-in lamp in accordance with claim 1, characterized in that the additional reflector (7) is made to be specularly reflecting or diffusely reflecting.

9. A built-in lamp in accordance with claim 1, characterized in that the direct light reflector (4) is made to be specularly reflecting on its inner side.

10. A built-in lamp in accordance with claim 1, characterized in that the direct light reflector (4) is made to be specularly reflecting on its outer side.

11. A built-in lamp in accordance with claim 1, characterized in that the bulb (6) is located inside the direct light reflector (4) and/or between the direct light reflector (4) and the additional reflector (7).

12. A built-in lamp in accordance with claim 1, characterized in that the translucent scattering plate (13) and the plate (13), which is in particular transparent, are made in one piece.

14. A built-in lamp in accordance with claim 1, characterized in that the polygonal line is a rectangular or square line (8).

15. A built-in lamp in accordance with claim 1, characterized in that the direct light reflector (4) is held pivotably in the housing (10).

16. A built-in lamp in accordance with claim 1, characterized in that a common inclination of the direct light discharge region (1) with the diffuse light discharge region (2) is adjustable with respect to the installation surface (11) by a pivoting of the direct light reflector (4); or

in that an inclination of the direct light discharge region (1) is adjustable with respect to the diffuse light discharge region (2) by a pivoting of the direct light reflector (4).

17. A built-in lamp in accordance with claim 1, characterized in that the direct light reflector (4) is held pivotably in the housing (10) together with the bulb (6).

**APPENDIX B**

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

**APPENDIX C**

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.